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09/756,077	01/08/2001	Wayne A. Provost	14689.10	6455

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EXAMINER

BLECK, CAROLYN M

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,077

Applicant(s)

PROVOST ET AL.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-27 and 36-39 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 28-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the election made in the response filed 1 April 2005. Claims 1-27 and 36-39 are pending. Claims 28-35 have been cancelled without prejudice.

Election/Restrictions

2. Applicant's election without traverse of 28-35 in the reply filed on 1 April 2005 is acknowledged. Applicant has cancelled these claims.

Claim Objections

3. Claims 1 and 22 are objected to for the language "including performing the acts of..." and "that includes" because it is not clear from the claim language whether these particular steps are actively performed or are required within the pending claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-27 and 36-39 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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(A) Claim 6 recites "if it has been determined that the insurance claim is eligible for advance payment, performing the following acts." This is a conditional step. There is no requirement within claim 6 that this step must occur. It is unclear to the Examiner what happens when the claim is ineligible for advance payment. It appears that the claim would then constitute the steps of "receiving, at the client computer...", "transmitting an insurance claim...", and "determining, by the remote server computer..." Applicant is respectfully requested to clarify what happens when a claim is ineligible for advance payment. Similar analysis is applied to claims 1, 22, and 36 which also recite conditional steps or limitations.

(B) Claims 2-5, 7-21, 23-27, and 37-39 incorporate the deficiencies of claims 1, 6, 22, and 36.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

7. Claims 1-27 and 36-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyer et al. (6,208,973).

(A) As per claim 1, Boyer discloses in a point of service third party adjudicated payment system including providers, an internet bank, a credit card network, and third party

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payors, a method for transferring funds to the provider in response to an insurance claim, and prior to the third party payor paying the claim comprising (Abstract, Fig. 1):

(a) receiving an insurance claim that included patient information (Patient ID), insurance information (Policy ID), and treatment information from the health care provider computer (Fig. 2A, 4, 7, col. 13 lines 8-41);

(b) adjudicating the insurance claim to determine whether a claim is eligible for third party payment (reads on "advance payment" because the third party payor reimburses the Internet bank, wherein the Internet bank paid for the portion owed by the third party payor) including determining whether the treatment is covered based on the insured's policy and verifying the patient's eligibility (col. 10 line 21 to col. 11 line 18, col. 12 lines 20-36, col. 13 lines 40-55, col. 14 line 45 to col. 15 line 18);

(c) sending the claim information associated with the insurance claim to the Internet bank, wherein the Internet bank executes a direct deposit of funds into the healthcare providers account (col. 10 line 21 to col. 11 line 18); and

(d) exchanging information over the Internet between the Internet bank and the third party payor (healthcare administrator or insurance company), wherein the third party payor transfers the portion of the insurance claim it is obligated to pay to the healthcare provider's account via the Internet bank (col. 10 line 21 to col. 11 line 18).

(B) As per claim 2, Boyer discloses receiving from the healthcare providers computer, while treating the patient, another insurance claim to be adjudicated that includes

additional treatments, and determining whether the treatment is covered by the Internet bank or adjudicated third party payment system (col. 13 line 8 to col. 14 line 15).

(C) As per claim 3, Boyer discloses the adjudication engine identifying the healthcare transaction amount to be paid by the patient and the amount of the healthcare transaction to be paid by the third party payor and transmits the amount to the health care provider computer (Fig. 5-7, col. 15 lines 1-6).

(D) As per claim 4, Boyer discloses rejecting or accepting a claim through the healthcare provider web browser for payment by the third party payor and Internet bank (col. 13 lines 9-65, col. 15 lines 19-52).

(E) As per claim 5, Boyer discloses providing a healthcare bill from the Internet bank that identifies how much money the Internet bank will transfer to the healthcare provider (Fig. 5-7, col. 11 lines 1-18).

(F) As per claim 6, Boyer discloses in a point of service third party adjudicated payment system including providers, an internet bank, a credit card network, and third party payors, a method for transferring funds to the provider in response to an insurance claim, and prior to the third party payor paying the claim comprising (Abstract, Fig. 1):

(a) receiving an insurance claim that included patient information (Patient ID), insurance information (Policy ID), and treatment information from the health care

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provider computer in an electronic claim form (Fig. 2A, 4, 7, col. 13 lines 8-41, col. 14 lines 22-44, col. 15 lines 19-34);

(b) transmitting the on-line claim through the Internet to the Internet bank, wherein the claim includes patient information (Patient ID), insurance information (Policy ID), and treatment information (Fig. 2A, 4, 7, col. 13 lines 8-41, col. 14 lines 3-53, col. 15 lines 19-34);

(c) adjudicating the insurance claim to determine whether a claim is eligible for third party payment (reads on "advance payment" because the third party payor reimburses the Internet bank, wherein the Internet bank paid for the portion owed by the third party payor) including determining whether the treatment is covered based on the insured's policy and verifying the patient's eligibility (col. 10 line 21 to col. 11 line 18, col. 12 lines 20-36, col. 13 lines 40-55, col. 14 line 45 to col. 15 line 18);

(d) transmitting claim information from the healthcare provider computer to the Internet bank, adjudication engine, and third party payor, where the adjudication engine identifies the healthcare transaction amount to be paid by the patient and the amount of the healthcare transaction to be paid by the third party payor and transmits the amount to the health care provider computer (Fig. 1, 7, col. 15 lines 1-6);

(e) transferring by the third party payor, the portion of the insurance claim that it is obligated to pay (col. 11 lines 1-18); and

(f) distributing by the Internet bank, credit between a disbursement account and the third party payor's account or payment account (col. 11 lines 1-18, col. 16 lines 52-61).

(G) Claim 7-9, 10, 12, 14, and 16-18 repeat limitations from claims 1-5, and are therefore rejected for the same reasons as claims 1-5.

(H) As per claim 11, Boyer discloses the third party payor processing the claim after the Internet bank transmits the information to the third party payor (col. 10 line 22 to col. 11 line 34).

(I) As per claim 13, Boyer discloses the third party payor transferring the portion of the insurance claim that it is obligated to pay (col. 11 lines 1-18);

(J) As per claims 19-21, Boyer discloses providing information relating to the amount the third party payor is responsible for and the amount to be paid by the patient or co-payment to the health care provider computer, where the card holder (i.e. patient) reviews the bill at the health care providers office (Fig. 5-7, col. 2 lines 52-67, col. 14 line 45 to col. 15 line 34).

(K) Claim 22 is a combination of the steps recited in claims 1, 2, and 6, and is therefore rejected for the same reasons as those claims, and incorporated herein.

(L) Claims 23 and 25-27 repeat the limitations of claims 3 and 19-21, and is therefore rejected for the same reasons as those claims.

(M) As per claim 24, Boyer discloses the CPT codes and diagnosis codes (Fig. 7, col. 9 lines 24-35).

(N) Claims 36 and 38-39 repeat the limitations of claims 1, 3, 6, and 19-21, and is therefore rejected on the same reasons as those claims, and incorporated herein.

(O) As per claim 37, Boyer discloses entering data into an electronic claim form, such as patient information, insurance information, and treatment information (col. 14 lines 21-45).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches a medical insurance verification and processing system (4,491,725), method and system for providing verifiable line of credit information (5,025,138), health insurance management system (5,235,507), health care payment adjudication and review system (5,359,509), medical transaction system (5,644,778), system and method for supporting delivery of healthcare (6,012,035), method for accelerated provision of funds for medical insurance using a smart card (6,820,058), and automated insurance system and method (US 2002/0002475).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

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(571) 273-6767 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

June 9, 2005


JOSEPH THOMAS
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